

Application No. 10/643,689
Attorney Docket No. 21723-0002

E) REMARKS

This Response is filed in response to an Office Action dated October 28, 2004.
Upon entry of this Response, claims 1-40 will be pending in the Application.
In the outstanding Office Action, the Examiner subjected claims 1-40 to a restriction requirement under 35 U.S.C. § 121.

Restriction/Election under 35 U.S.C. 121

The Office Action subjects claims 1-40 of the present Application to a restriction requirement. The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

- Group I. Figure 11.
- Group II. Figure 12.
- Group III. Figure 13.
- Group IV. Figure 14.
- Group V. Figure 15.
- Group VI. Figure 16.
- Group VII. Any other unillustrated species.

In accordance with the requirements of 37 C.F.R. § 1.143, Applicant provisionally elects the embodiment of Group V which pertains to claims 1-2, 4-32 and 40. Furthermore, claim 1 is generic to Groups I-VI as being embodied in the figure of each group. Applicant is confused by the designation of Group VII which is directed to an unillustrated species.

Applicant respectfully traverses the requirements for restriction and requests reconsideration of the restriction requirement between the Group I-VII embodiments.

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The Examiner states that the present application contains claims directed to the following patentably distinct species Groups I-VII, but has conceded that claim 1 appears to be generic.

Applicant respectfully traverses this requirement for restriction. The Examiner has merely stated that the embodiments of Groups I-VII are patentably distinct species from each other, but failed to provide any support for this position.

As can be seen from the recitations of independent claims 1, 33, 39 and 40 as originally filed, independent claim 1 recites a plate heat exchanger construction and independent claims 33, 39 and 40 each recite a method for providing an enhanced heat transfer surface for use with a plate heat exchanger.

The restriction is made pursuant to 35 U.S.C. § 121. The claims must be shown to be "independent and distinct" to maintain the restriction, 35 U.S.C. § 121, 37 C.F.R. § 1.141, MPEP 802. Since this requirement is statutory, it is not proper to interpret the statute in any other fashion. In this case, the embodiments of Groups I-VI (Figures 11-16, respectively) and the corresponding claims are not both independent and distinct. Since Group VII is of speculative nature, it is not discussed.

The restriction asserts that the inventions are "patentably distinct", but does not address the question of whether the inventions of the embodiments of Groups I-VI (Figures 11-16, respectively) are "independent", as required by the statute, the regulation, and the MPEP.

Applicant submits that the inventions of the embodiments of Groups I-VI (Figures 11-16, respectively) are not "independent". The term "independent" is defined in MPEP 802.01:

The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect...

The restriction can be made only "If it can be shown that the two or more inventions are in fact independent...", MPEP 806.04.

As made quite clear in the specification, the subject matter of the embodiments of Groups I-VI (Figures 11-16, respectively) is not "independent." Specifically, the disclosed relationship

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is that of a plate heat exchanger construction and method for providing an enhanced heat transfer surface for use with a plate heat exchanger.

Additionally, there is no undue burden placed on the patent office by examining all of the claims of corresponding to the inventions of the embodiments of Groups I-VI (Figures 11-16, respectively). The rules provide:

On taking up an application for examination or a patent in a reexamination proceeding, the Examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(37 CFR 1.104(a)).

There has been no showing that a search of the art would pose a serious burden on the Examiner, and should be searched. Even multiple art classes/subclasses are routinely searched when applications are examined. MPEP 803 states:

If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(Emphasis added)

Given that 37 CFR 1.104(a) mandates a thorough examination, which would presumably include searching in multiple art classes, the mandate of MPEP 803 requires that the inventions be examined. If the restriction is maintained, Applicant asks that the Examiner demonstrate why a search would pose a serious burden. Applicant wants a thorough search of its invention, and is concerned that the search may be less than thorough if certain search classes are arbitrarily excluded for restriction reasons.

CONCLUSION

In summary, it is respectfully submitted that for the reasons given above the restriction requirement between the inventions as set forth in claims 1-40 and illustrated in Figures 11-16

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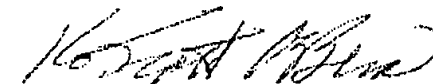
(Groups I-VI) should be examined and the restriction requirement reconsidered and withdrawn by the Examiner. A favorable action is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,

McNEES, WALLACE & NURICK LLC

By



K. Scott O'Brian
Reg. No. 42,946
100 Pine Street, P.O. Box 1166
Harrisburg, PA 17108-1166
Tel: (717) 237-5492
Fax: (717) 237-5300

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Response Under 37 C.F.R. 1.111 (8 pages)

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